

In order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect to prosecute the subject matter of Group I, Claims 1-18, and reserve the right to file a divisional application directed to the non-elected subject matter of the remaining claims in this application.

However, Applicants respectfully traverse the present restriction requirement and request reconsideration of this restriction requirement in view of the following remarks.

It was previously held that claims sharing common subject matter which merely provide additional limitations to perfect the basic inventive concept are therefore so interwoven as to constitute a single invention to be examined together. See, In re Application of Leber, Decision on Petition, filed July 20, 1987, Serial No. 902,864, published in PRI opinions on December 3, 1990; a copy of which is attached herein. In the present case, all of the claims of the present invention share common subject matter related to methods for harvesting components from a sample, as set forth in independent Claims 1, 10 and 31. Claim 1 is directed to a method for harvesting components from a sample, wherein a target component is ultimately obtained from said sample; Claim 19 is directed to a method of harvesting a target component from a sample; and Claim 31 is directed to a method of harvesting a target component from a sample wherein the sample is whole blood.

In view of this, Applicants respectfully submit that all of Claims 1-36 share common subject matter, the "Groups" are not distinct, and the present restriction requirement is improper. Thus Applicants respectfully request that the present restriction requirement be withdrawn.

Applicants further respectfully submit that, at the very least, Groups I and III should be examined together, since they are both classified in the same class, Class 435.

It should also be observed that a requirement for restriction is not mandatory under either 35 U.S.C. §121 or 37 C.F.R. §1.142, it is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made restriction requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 USPQ 98 (E.D. Va. 1966), aff'd, 374 F. 2d 511, 153 USPQ 91 (4th Cir. 1967). In addition, the courts have recognized the advantages to the public interest to permit a patentee to claim all aspects of its invention, as the Applicants have done herein, so as to encourage the patentee to make a more detailed disclosure of all aspects of its discovery. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in a manner required by 35 U.S.C. §113 all aspects of what they regard as their invention; regardless of the number of statutory classes involved. *In re Kuehl*, 177 USPQ 250, 256 (CCPA 1973). (Emphasis added).

Furthermore, Applicants respectfully suggest that in view of the continued increases of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional intent to promote and encourage the progress of science and the useful arts.

Thus, it is again respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,



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GROUP 130

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In re application of
Leland C. Leber et al
Serial No. 902,864
Filed: September 2, 1986
For: CABINET CONTROLLER



Decision on Petition
Filed
July 20, 1987
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Applicants petition the Commissioner to direct the examiner to vacate the restriction requirement and examine all the claims.

Applicants argue that the examiner has placed some claims in the wrong group and that there is common subject matter between the claims of Group I and Group II.

The present case has been reviewed taking into account all of applicants comments set forth in their petition. A comparison of the claims indicates that the subject matter therein is so interwoven that they constitute a single invention with the additional limitations being a mere perfection of the basic concept. It is noted that the Examiner has not properly responded to applicants traversal.

For the reasons set forth in applicants petition and those noted above, applicants petition is hereby granted.

Since the applicants petition has been granted, the Office action of June 29, 1987 is hereby vacated. The case is being forwarded to the examiner and the examiner is directed to submit a supplemental action addressing all the claims.

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